

## **Claim Rejections - 35 USC Section 112**

The Examiner rejects claims 1-12 under this section "...as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." More specific rejections will be addressed below.

Claim 1, line 1 is rejected because "...it is not clear what aspects of a cart associated with the term conventional are or are not being recited." Applicant admits to being somewhat unsure as to what the objection is to this claim and requests further clarification. Applicant would happily amend this claim to make it more clear. Perhaps an amendment such as the following would make the claim more distinct.

1. A shopping cart extender to be used as an attachment to [for use in conjunction with] a conventional shopping cart...

Claims 2 and 3 are rejected because "...it is not clear what is meant by "forward" or "rearward" of vertical insofar as the term vertical does not presume a forward or rearward direction..." In claim 1 the bar is engaged when in a vertical position. The shopping cart in claim 1 has a rearward end. Applicant believed that it was clear in claim 2 that the bar was engaged in a position in which the bar was rotated such that the top of the bar was forward of the bottom of the bar. Applicant believed that it was clear in claim 3 that the bar was engaged in a position in which the bar was rotated such that the top of the bar was rearward of the bottom of the bar. However in an effort to make claims 2 and 3 more definite, Applicant requests that these two claims be amended.

Please amend claim 2 as indicated in the attached claim sheet where claim 2 is identified as being (Currently amended).

Please amend claim 3 as indicated in the attached claim sheet where claim 3 is identified as being (Currently amended).

Claims 4-6 were rejected by the Examiner because "...it is not clear what is meant by the phrase "where upward is with the shopping cart extender engaged" insofar as "upward" is not understood to depend on further conditions." In an effort to make claims 4-6 more definite, Applicant requests that these three claims be amended.

Please amend claim 4 as indicated in the attached claim sheet where claim 4 is identified as being (Currently amended).

Please amend claim 5 as indicated in the attached claim sheet where claim 5 is identified as being (Currently amended).

Please amend claim 6 as indicated in the attached claim sheet where claim 6 is identified as being (Currently amended).

The Examiner rejects claims 7-12 because "...it is not entirely clear whether or not the recitation is a further limitation of the extender (note the preamble to claim 1: "a shopping cart extender" and the limitations recited therein), the cart, or another element. In an effort to make these claims more definite, Applicant requests that claims 7-12 be amended.

Please amend claim 7 as indicated in the attached claim sheet where claim 7 is identified as being (Currently amended).

Please amend claim 8 as indicated in the attached claim sheet where claim 8 is identified as being (Currently amended).

Please amend claim 9 as indicated in the attached claim sheet where claim 9 is identified as being (Currently amended).

Please amend claim 10 as indicated in the attached claim sheet where claim 10 is identified as being (Currently amended).

Please amend claim 11 as indicated in the attached claim sheet where claim 11 is identified as being (Currently amended).

Please amend claim 12 as indicated in the attached claim sheet where claim 12 is identified as being (Currently amended).

Reconsideration of the application as amended is respectfully requested.

### **Claim Rejections - 35 USC Section 103**

The Examiner rejects claims 1-12 under 35 USC 103(a), which indicates that "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

Section 103(a) rejections have been examined in cases such as *Pentec, Inc. v. Graphic Controls Corp.*, 766 F.2d 309, 227 USPQ 766 (CAFC 1985); *In re Find*, 837 F.2d 1071, 5

USPQ2d 1596 (CAFC 1988); and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (CAFC 1983), cert. denied, 469 US 851 (1984). These cases indicate that section 103 rejections must be determined by looking at the problem from the point of view of the inventor at the time of the invention and may not be based upon hindsight with the invention reconstructed based upon the a blueprint supplied by the applicant's claims. As indicated by the court in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543, 551 (CAFC 1985) there must be some objective reason for making a combination of prior art references other than hindsight obtained from the invention itself.

Under a variety of other cases including *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1297 (CAFC 1989), *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990), and *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (CAFC 1994) it is not enough simply to find the elements of an invention in the prior art and to postulate that such a combination *could* occur. There must be some teaching or indication in the prior art that such a combination is desirable. Any rejection of claims is improper under section 103, if no teaching, suggestion, or incentive supporting the combination is found in the prior art. Also see MPEP Section 2143.01.

The Examiner rejected claims 1-6 under Section 103(a) as being unpatentable over Werner (US 6,641,147; "Werner") in view of Baumgart (2,845,729; "Baumgart").

Applicant does admit that Werner does appear to disclose some form of front end adjustable load holder which may be a part of a shopping cart; but, of course, argues that the carrier 98 teaches away from the instant invention. The carriers 98 are described as being a pair and are always referenced as being used together, col. 4, lines 46-65. For example, "In this drawing [Fig. 7] the carriers 98 are shown holding a 2x10 inch piece of dimensional lumber 104." Furthermore, the carriers in Werner are "slidably attached" to two mounting plates 96 which are affixed to the front and rear of the shopping cart. The carriers may be slid up or down such that the lumber, for instance, may be held in a horizontal position. Applicant asserts that this definitely teaches away from the instant invention. The bar of the instant invention is intended to be used as a stand alone element and does not require a second element in order to be fully operational. Oversize materials are carried in the instant invention by resting one end on the bar and the other end on the handle of the shopping cart.

Furthermore, Werner discloses a fairly complicated method of securing objects within the carriers. Apparently adjustable cross supports 100 attached to the sides of the carriers 98 and the tops of the carriers 98 create an adjustable opening 102 which may be adjusted in size to accommodate articles of different dimensions. The instant invention includes no such elements. In the instant invention a pair of ears protrude upward from the ends of the bar and the ears hold the article in place between them.

According to MPEP Section 2144.04, II., B., "Omission of an Element with Retention of the Element's Function Is an Indicia of Unobviousness." Applicant believes and asserts that the bar of the instant invention (with or without ears) coupled with the handle of a shopping cart works at least as well as the much more complicated system disclosed in Werner. The single, simple bar of the instant invention may be flipped up and engaged and oversized articles carried easily and conveniently on a conventional shopping cart. The embodiment of the invention disclosed in Werner requires two mounting plates, two "U" shaped carriers, a method of slidably affixing the carriers to the mounting plates, and an adjustable opening to perform the same function as the bar of the instant invention. Because it eliminates a number of elements of Werner and performs the same function, the instant invention is unobvious in light of Werner.

The Examiner admits that Werner "...fails to teach the bar portion as being pivotable between load-accomodating and nesting-cart positions, and further having an engaging portion to facilitate the load-accomodating position." However, the Examiner asserts that Baumgart teaches a pivotable connection and an engagement portion. The Examiner asserts that "it would have been obvious to one of ordinary skill in the art at the time of the invention" to combine Werner with Baumgart to create the instant invention.

Although Baumgart may appear to disclose some element which is rotatably affixed to the front end of a shopping cart, Applicant argues that it does not disclose "...an engaging portion to facilitate the load-accomodating position." Baumgart discloses a display sign which is vertical when on display but rotates rearward and downward so that carts may be nested. The sign is urged toward its upward position by a pair of springs, col. 3, lines 7-12, or by two pairs of springs, col. 4, lines 8-16. Applicant argues that this does not disclose an engagement means as the sign never engages anything. It is simply held in place by the force of springs. The *Merriam-Webster Dictionary*, Merriam-Webster, Incorporated, 2004, includes the relevant

definition of “engage” as “to connect or interlock with.” Applicant urges that, since the sign in Baumgart does not connect or interlock with anything, Baumgart does not disclose an engagement means which serves to make the instant invention obvious.

Even if it were proper to combine Werner with Baumgart (which Applicant strongly disputes), the combination of Werner and Baumgart does not disclose the instant invention. MPEP Section 2143 sets out the requirements for establishing a *prima facie* case of obviousness. The third requirement is that “...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Applicant urges that the combination of Werner and Baumgart does not teach or suggest all the claim limitations. Neither discloses an engagement means and neither discloses a rotating bar which may accommodate the carrying of oversized articles on a shopping cart.

The first requirement of MPEP Section 2143 and references cited above is “...there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” Applicant asserts that there is nothing in either Werner or Baumgart to suggest such a combination. There is no hint in Werner that the load-accommodating element could or should be made to rotate. There is no hint in Baumgart that the display sign could be used to carry oversized articles.

Perhaps one of the most effective arguments against there being some suggestion or motivation to combine Werner and Baumgart is that Werner would have included a nestable embodiment of the shopping cart if he had thought of it. Applicant asserts that Werner may be considered a person knowledgeable in the art. If it wasn’t obvious to him, it shouldn’t be considered obvious. It is only in hindsight that such a combination is obvious.

MPEP Section 2143.02, VI. further suggests that “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” The principle of operation of the forward carrier in Werner is a firmly affixed strut which protrudes vertically from a mounting plate. The bottom ends of the carrier are slidably affixed to the mounting plate such that the level of the carrier may be adjusted by sliding the carrier up and down relative to the mounting plate. It would probably be possible to design

some sort of hinge and engagement means which would allow the carriers in Werner to rotate for nesting, but it would certainly change the principle of operation of the carrier in Werner.

MPEP Section 2143.01, I., indicates that the prior art must suggest the desirability of the claimed invention. Applicant asserts that Baumgart actively teaches away from any combination of Werner and Baumgart to create the instant invention. The purpose of Baumgart is to create a display sign which contains advertising which is "...constantly before the customer during an entire shopping operation. It has been found that the sales of items advertised in this manner have been materially increased, and even in the case of "hard-to-move" items, or items with a large price "markup," the sales have increased many fold." Col. 1, lines 30-40. The sole purpose of Baumgart is to create advertising which faces the operator of the cart for the entire time the operator is pushing the cart. If the Baumgart cart were modified such that it could be used to carry oversized articles as in Werner and the instant invention, the entire purpose of Baumgart would be defeated. That is, the person operating the cart wouldn't be able to see the advertising. Therefore, Baumgart aggressively teaches against the desirability of the instant claimed invention.

Under MPEP 2145, IX., prior art may not be considered in determining obviousness if the prior art is not analogous to the field of the applicant's invention or reasonably pertinent to the particular problem with which the inventor is concerned. Applicant argues that Baumgart is not analogous to the instant invention or reasonably pertinent to the particular problem with which the inventor is concerned. The Applicant was dealing with and concerned with the problem of carrying oversized articles on a shopping cart. Baumgart deals with getting advertising in front of the operator of a shopping cart. Although both inventions have something to do with shopping carts, the problems they address could not be more different. Baumgart is not analogous to the instant invention and is not reasonably pertinent to the problem addressed in the instant invention.

In summary, Applicant urges that the instant invention is not obvious in light of either Werner or Baumgart or in any combination of the two. Viewing the instant invention and Werner and Baumgart as a whole, there is nothing to suggest the desirability or obviousness of a combination of Werner and Baumgart. Even if it were proper to combine Werner and Baumgart to make the instant invention obvious, the very simple elements of the instant invention (a

rotating bar and engagement means) are not found in a combination of Werner and Baumgart as, for instance, there is no engagement means in Baumgart.

The Examiner rejects claims 7-12 as being unpatentable over Werner in view of Baumgart and Duer (US 5,429,377; "Duer"). Applicant generally asserts the indication of MPEP Section 2143.03 and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), that "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." As claims 7-12 depend (eventually) from claim 1, if claim 1 is not obvious from the arguments made above, claims 7-12 are not obvious.

Applicant asserts, without reproducing them, all of the above arguments relating to the combination Werner and Baumgart. Applicant further asserts that all of the above indicia against the combination of prior art applies to Duer as well. Duer discloses a sanitary cover which can be carried from store to store and attached to the handles of shopping carts, Abstract. Duer discloses a wide variety of shopping cart handles and methods for shaping and affixing the sanitary covers to those shopping cart handles. The fact that a few of the handles happen to have what might be considered "ears" is actually irrelevant to the Duer invention when taken as a whole. There is no discussion or indication of the purpose or function of these "ears" and there appears to be no indication whatsoever that it would be useful to combine the illustration of "ears" in Duer with either Werner or Baumgart.

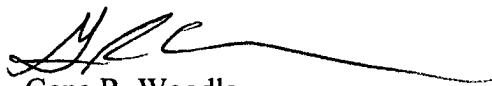
Under MPEP 2145, IX., prior art may not be considered in determining obviousness if the prior art is not analogous to the field of the applicant's invention or reasonably pertinent to the particular problem with which the inventor is concerned. Applicant argues that Duer is not analogous to the instant invention or reasonably pertinent to the particular problem with which the inventor is concerned. The Applicant was dealing with and concerned with the problem of carrying oversized articles on a shopping cart. Duer deals with providing a sanitary cover for the handle of a shopping cart. Although both inventions have something to do with shopping carts, the problems they address could not be more different. Duer is not analogous to the instant invention and is not reasonably pertinent to the problem addressed in the instant invention.

### **Conclusion**

For all of the foregoing reasons, the applicant submits that the shopping cart extender disclosed and claimed in the present application is not fairly taught by any of the references of

record, taken either alone or in combination. Therefore, allowance of the present application is in order, and is requested.

Respectfully submitted;



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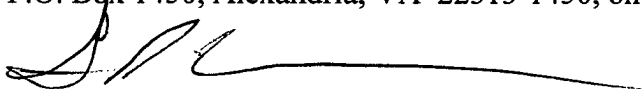
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Dated: May 13, 2005

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